

REMARKSI. Election/Restriction

In an Examiner Interview conducted over the telephone on October 9, 2003, the Examiner indicated that although Applicant had elected Species II, because Species I and II were very close embodiments that if the independent claims of Species I and Species II were amended to form a proper genus for the dependent species claims, then the Examiner would consider all of the claims. Applicant respectfully submits that these claims, as amended, form a single genus from which the dependent claims are species thereto. Therefore, applicant respectfully requests that Claims 23-31, 33 and 34 be considered by Examiner in light of the claim amendments offered in this preliminary amendment.

II. Rejections Based on 35 U.S.C. §102

In the Office Action dated October 20, 2003, claims 23-31, 33 and 34 were withdrawn from consideration and the Examiner rejected Claims 18-21 and 32 under 35 U.S.C. §102(b) as being anticipated by Caplan, Claims 18, 19, and 22 under 35 U.S.C. §102(b) as being anticipated by Franklin, Claims 18, 19, and 22 under 35 U.S.C. §102(b) as being anticipated by Pflueger, Claims 18, 20, 21, and 32 under 35 U.S.C. §102(b) as being anticipated by Hicks, Claims 18-21 and 32 under 35 U.S.C. §102(b) as being anticipated by

Hudson, Claims 18-21 and 32 under 35 U.S.C. §102(b) as being anticipated by Pieper, and Claims 18, 20, 21 and 32 under 35 U.S.C. §102(b) as being anticipated by Zander. Furthermore, the Examiner cited Rose in an email dated December 18, 2003.

Applicant has cancelled Claim 20 without prejudice or disclaimer. With respect to the remaining claims subject to this rejection, Applicant respectfully submits that these claims, as amended, are not anticipated by Caplan, Franklin, Pflueger, Hicks, Hudson, Pieper, Zander, Rose, or any other reference.

Attached to the preliminary amendment is a Declaration setting forth the applicant's expertise and analysis of the differences between the applicant's invention and the prior art references.

Applicant has amended Claim 18, upon which Claims 19-22 depend, and Claim 32 to more patentably distinguish Claims 18-22 and 32 over the prior art. In this regard, Applicant has added to Claims 18 and 32 the feature of more than twenty plastic-type strands helically braided together to form a mesh-like configuration defining a plurality of apertures between the plastic-type strands. This feature was present in Figures 1-6, among other places in the Specification, and thus this amendment is supported by the Specification. Applicant has also added to Claim 1 the feature that the plastic-type strands extend from the

second end of the sleeve to the first end, terminating at the first end of the sleeve, with the first end of each terminated plastic-type strand being fused together with a first end of an opposing plastic-type strand to form an opening defined by the first end of the sleeve. This feature was present in Figures 1-6, among other places in the Specification, and thus this amendment is supported by the Specification.

Applicant respectfully submits that none of the prior art references shows more than 20 plastic-type strands helically braided together to form a mesh-like configuration defining a plurality of apertures between the plastic-type strands. Nor do any of the prior art references show plastic-type strands extending from one end of the sleeve and terminating at the other and being fused together with an opposing strand to form an opening.

Many of the prior art references cited by the Examiner have an additional piece of hardware that is necessary to either insert bait or retain bait in a receptacle. For example, Caplan requires a draw string (see Figure 4 and Column 2, Lines 19-21) in order to insert the bait and secure it, whereas applicant's invention is dimensioned to permit insertion of the bait without the need for any additional steps and/or hardware. Hicks requires scale elements to retain bait in the holder (see Figures 1-4 and Column

2, Lines 55-60). Hudson utilizes both a hook to hold bait in the transparent member as well as a separate sealing member to keep the bait in position (see Figures 1-2, and Column 2, Lines 51-53). Pieper requires a bead to close the sleeve in order to keep the contents enclosed therein (see Figures 1 and 3, and Column 2, Lines 28-32). Finally, Zander requires that both the head and the tail of its fishing lure be closed in order to secure bait therein (see Figure 1 and Column 3, Lines 25-27).

Many other prior art references disclose devices in which no bait is inserted, unlike applicant's invention which is designed to receive bait. For example, Franklin discloses a rubber tube member which acts as a bait, and is not dimensioned to retain bait (see Figures 1-2 and Column 1, Lines 19-21). Similarly, Pflueger discloses an artificial minnow that does not retain any bait (see Figures 1-2, and Column 1, Lines 16-18).

Accordingly, for the foregoing reasons, Applicant respectfully submits that Claims 18-21 and 32 are not anticipated by Caplan, Franklin, Pflueger, Hicks, Hudson, Pieper or Zander.

III. Rejections Based on 35 U.S.C. § 103

In the Office Action dated October 20, 2003, the Examiner rejected Claim 19 under 35 U.S.C. §103(a) as being unpatentable over Caplan, Franklin, Hicks, Hudson, Pieper and Zander. The

Examiner also rejected Claim 22 under 35 U.S.C. §103(a) as being unpatentable over Zander in view of Franklin or Allman or Dillon or Pflueger.

Independent Claim 18, upon which Claims 19 and 22 depend, has been amended to more patentably distinguish over the cited art. For the same reasons that Claim 18 is not anticipated by Caplan, Franklin, Poflueger, Hicks, Hudson, Pieper or Zander, Applicant respectfully submits that Claims 19 and 22, which depend on amended Claim 18, are also patentably distinguishable over Caplan, Franklin, Pflueger, Hicks, Hudson, Pieper, Zander, Allman, and Dillon.

The Examiner also cited Rose in an email and Anselmi in an Examiner interview as prior art references.

Specifically, Anselmi utilizes metal wire braids for the purposes of keeping a live eel from wriggling out of the sleeve (see Column 1, Lines 34-38 and Column 2, lines 23-26 and). The metal wires are sufficiently rigid that in order for them to expand, pressure must be applied to opposite ends of the harness (see Column 2, Lines 42-47). Applicant respectfully submits that Anselmi does not show a sleeve capable of expanding to a larger diameter as a bait is inserted and without manually applying any force to any other portion of the sleeve to expand the sleeve. In order to insert bait into the Anselmi device, "pressure is exerted

against opposite ends of the harness 3 effecting a circumferential expansion" (Column 2, Lines 48-49). Due to the use of plastic-type strands, instead of metal that Anselmi uses, no such pressure is necessary to insert bait in Applicant's device.

In addition, it should be noted that Anselmi requires a three-step process in order to insert bait into the harness: 1) the harness must be manually enlarged by pushing opposite ends of the harness towards one another; 2) the bait must then be inserted into the harness while continuing to maintain pressure on both ends of the harness; and 3) the opposite ends of the harness must be released in order for the harness to grip the bait.

Applicant's sleeve expands as the bait is inserted, without the need for the extra steps of squeezing and subsequently releasing the sleeve. Thus, Applicant's invention is substantially easier to use than the Anselmi device, requiring one step for use, instead of three.

Furthermore, it would not be obvious to use a plastic-type material in place of metal in the Anselmi device since a plastic sleeve is not sufficiently strong enough to keep a live eel from wriggling out. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the

proposed modification. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984).

There is no suggestion in Anselmi or Rose of making the harness out of a plastic-type material such as polyethylene terephthalate or any other material capable of expanding as a bait is inserted into a sleeve and without the need to exert any pressure on the sleeve in order to receive a bait. In order to combine Anselmi or Rose with and any reference that suggests the use of plastic to satisfy the obviousness requirement, it is not enough that one could manufacture the Anselmi or Rose invention with plastic or polyethylene terephthalate, there must be a suggestion for the use of such material (*Fromsom v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination)). There is no such suggestion of using a plastic-type material or polyethylene terephthalate in either Anselmi or Rose. Caplan utilizes plastic for the purpose of holding a live fish without injuring it (see Column 1, Lines 36-39) and because plastic is inexpensive to manufacture (see Column 1, Lines 39-44). Franklin uses rubber (not plastic) to simulate the shape of an eel (see Column 1, Lines 19-21). Hicks utilizes polypropylene because of its transparency (see Column 2, Lines 20-22) and its loose flexibility which will

keep the bait alive (see Column 1, Lines 32-34). The Examiner concedes that Hudson, Pieper and Zander references do not disclose using polyethylene terephthalate. The mere fact that the references may be combined or modified does not in itself render the resultant combination obvious. In re Mills, 916 F.2d 680 (Fed. Cir. 1990).

Applicant respectfully submits that the above comments relating to the § 102 rejection are equally relevant to the § 103 rejection. Applicant therefore respectfully submits that the subject patent claims are patentable over the cited prior art whether viewed as a § 102 or § 103 rejection. Applicant respectfully submits that Applicant's claimed invention is deserving of patent protection because it describes, in combination, a useful and functional device which patentably distinguishes over the cited prior art. In conclusion, Applicant respectfully submits that this Preliminary Amendment, in view of the Remarks offered herein, is fully responsive to all aspects of the objections and rejections tendered by the Examiner in the October 20, 2003 Final Office Action. Applicant respectfully submits that he has persuasively demonstrated that the above-identified Patent Application, including Claims 18-22 and 32, is in condition for allowance. Such action is earnestly solicited. Please call the undersigned if you have any questions.

If there are any fees incurred by this Amendment Letter,
please deduct them from our Deposit Account No. 23-0830.

Respectfully submitted,



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